

REMARKS

In the May 21, 2004 Office Action, the Examiner rejected claims 5-35, 74-80, and 85-94 pursuant to the judicially created doctrine of double patenting over claims of U.S. Patent No. 6,312,379. This rejection was reiterated in the Final Office Action dated October 14, 2004. Applicants had filed a terminal disclaimer on June 24, 2004 in response to the prior-stated rejection, but it was deemed defective insofar as a PTO/SB/96 was not submitted.

In order to expedite allowance of a patent based on the above captioned application, Applicants are enclosing herewith:

- the Terminal Disclaimer submitted June 24, 2004;
- a completed Form PTO/SB/96 in accordance with 37 C.F.R. §3.73(b); and
- a copy of the executed assignments, patent assignment Recordation Form Cover Sheet, and Notice of Recordation of Assignment from the parent patent application number 09/061,014 (US Patent No. 6,312,379).

Applicants respectfully submit that the Terminal Disclaimer conforms with 37 C.F.R. § 1.321(b). The present application is a divisional of patent application number 09/061,014 which was filed April 15, 1998 and issued as U.S. Patent No. 6,312,379. The assignee of the above referenced application and U.S. Patent No. 6,312,379 is Acuson Corporation. By filing the Terminal Disclaimer to expedite issuance, Applicants are not admitting that any of the claims of the above referenced application are obvious in light of the claims of either of these patents.

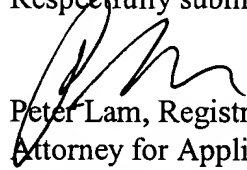
CONCLUSION:

Applicants respectfully submit that all of the pending claims are in condition for allowance and seeks early allowance thereof. If for any reason, the Examiner is unable to allow the application but believes that an interview would be helpful to resolve any issues, he is respectfully requested to call the undersigned at (650) 943-7350.

PLEASE MAIL CORRESPONDENCE TO:

Siemens Corporation
Customer No. 28524
Attn: Elsa Keller, Legal Administrator
170 Wood Avenue South
Iselin, NJ 08830

Respectfully submitted,


Peter Lam, Registration No. 44,855
Attorney for Applicant
Telephone: 650-943-7350
Date: 11/19/04



PTO/SB/26(10-00)

Approved for use through 10/31/2002. OMB 0651-003 1
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995. No persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A
PRIOR PATENT**

Docket No. 1997P82116US02

In re Application of Charles E. Bradley, et al.
Application No. 09/884,407
Filed: June 18, 2001
For: ULTRASONIC HARMONIC IMAGING SYSTEM AND METHOD USING
WAVEFORM PRE-DISTORTION

The owner, Acuson Corporation of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,312,379 B1. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent is commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon,

The undersigned is an Officer of Assignee.

Charles H. Dearborn, President, Acuson Corporation

Date: 6/18/01

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

* Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.



STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Charles E. Bradley, Gregory L. Holley, Laurence J. Newell, David J. Hedberg, Dave Napolitano

Application No.: 09/884,407 with Filing Date: June 18, 2001, which is a Divisional of App. No. 09/061,014 filed April 15, 1998.

Entitled: Ultrasonic Harmonic Imaging System And Method Using Waveform Pre-Distortion

Acuson Corporation, a corporation
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- ☒ the assignee of the entire right, title, and interest; or
- ☐ an assignee of less than the entire right, title and interest.
The extent (by percentage) of its ownership interest is _____ %

in the patent application/patent identified above by virtue of either:

A. ☒ An assignment from the inventor(s) of the PARENT patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _9432_, Frame _0228_, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

- From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
- From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
- From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☒ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.



Signature

Charles H. Dearborn

Printed or Typed Name

President, Acuson Corporation

Title

11/19/2004

Date

(650) 694-5003

Telephone Number

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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JANUARY 13, 1999

PTAS

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610



100865937A

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/24/1998

REEL/FRAME: 9432/0228
NUMBER OF PAGES: 10

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
BRADLEY, CHARLES E.

DOC DATE: 06/29/1998

ASSIGNOR:
HOLLEY, GREGORY L.

DOC DATE: 06/29/1998

ASSIGNOR:
NEWELL, LAURENCE J.

DOC DATE: 06/29/1998

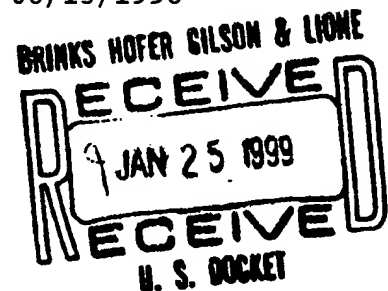
ASSIGNOR:
HEDBERG, DAVID J.

DOC DATE: 06/26/1998

ASSIGNOR:
NAPOLITANO, DAVE

DOC DATE: 08/13/1998

ASSIGNEE:
ACUSON CORPORATION
1220 CHARLESTON ROAD
MOUNTAIN VIEW, CALIFORNIA
94039-
7393



9432/0228 PAGE 2

SERIAL NUMBER: 09061014
PATENT NUMBER:

FILING DATE: 04/15/1998
ISSUE DATE:

STEVEN POST, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

12-23-1998

PATENTS ONLY

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PATENTS ONLY

TRADEMARKS

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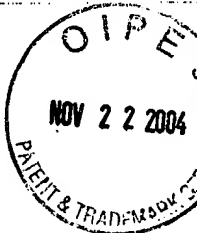
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opy thereof

AUG 24

1. Name of Party(ies) conveying an interest

Charles E. Bradley
Gregory L. Holley
Laurence J. Newell
David J. Hedberg
Dave Napolitano



2. Name and Address of Party(ies) receiving an interest

Name: Acuson Corporation

Internal Address:

Street Address:

City:

State/Zip:

1220 Charleston Road
Mountain View
94039-7393

CA

Additional name(s) and addresses attached?

☐ Yes ☒ No

MRD 8-24-98

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

3. Description of the interest conveyed:

☒ Assignment☐ Change of Name

Other:

☐ Security Agreement☐ Merger

Execution Date: June 29, 1998 and August 13, 1998

4. Application number(s) or patent number(s). Additional sheet attached? ☐ Yes ☐ No

If this document is being filed together with a new application, the execution date of the application is:

Date

A. Patent Application No.(s)

09/061,014

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610
(312)321-4200

6. Number of applications and patents involved: 1

7. Total fee (37 CFR 3.41)

\$ 40.00

☒ Enclosed☐ Authorized to be charged to Deposit Account No. 23-19258. ☒ Please charge any deficiencies in fee or credit any overpayment to Deposit Account No. 23-1925.

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09/27/1998 INVENT 00000199 09061014

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40.00

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Craig A. Summerfield
Name of Person Signing

Craig A. Summerfield
Signature

August 20, 1998
Date

Total number of pages including cover sheet, attachments, and document: 10

Case No. 5050/293**ASSIGNMENT**

WHEREAS, Dave Napolitano, hereinafter called the "Assignor", has made the invention described in the United States patent application entitled Ultrasonic Harmonic Imaging System And Method Using Waveform Pre-distortion, for a full description of which reference is here made to an application for Letters Patent of the United States filed on April 15, 1998, and assigned Application Serial No. 09/061,014;

WHEREAS, Acuson Corporation, a corporation organized and existing under the laws of the State of Delaware, having a place of business at Mountain View, California, hereinafter called the "Assignee", desires to acquire the entire right, title and interest in and to the invention and the patent application identified above, and all patents which may be obtained for said invention, as set forth below;

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00), and other valuable and legally sufficient consideration, the receipt of which by the Assignor from the Assignee is hereby acknowledged, the Assignor have sold, assigned and transferred, and by these presents do sell, assign and transfer to the Assignee, the entire right, title and interest for the United States in and to the invention and the patent application identified above, and any patents that may issue for said invention in the United States; together with the entire right, title and interest in and to said invention and all patent applications and patents therefor in all countries foreign to the United States, including the full right to claim for any such application all benefits and priority rights under any applicable convention; together with the entire right, title and interest in and to all continuations, divisions, renewals and extensions of any of the patent applications and patents defined above; to have and to hold for the sole and exclusive use and benefit of the Assignee, its successors and assigns, to the full end of the term or terms for all such patents.

The Assignor hereby covenant and agree, for both the Assignor and the Assignor's legal representatives, that the Assignor will assist the Assignee in the prosecution of the patent application identified above; in the making and prosecution of any other patent applications that the Assignee may elect to make covering the invention identified above; in vesting in the

Assignee like exclusive title in and to all such other patent applications and patents; and in the prosecution of any interference which may arise involving said invention, or any such patent application or patent; and that the Assignor will execute and deliver to the Assignee any and all additional papers which may be requested by the Assignee to carry out the terms of this Assignment.

The Commissioner of Patents and Trademarks is hereby authorized and requested to issue patents to the Assignee in accordance with the terms of this Assignment.

IN TESTIMONY WHEREOF, the Assignor have executed this agreement.

DATED:

8/13/98



Dave Napolitano

DATED:

STATE OF CALIFORNIA)
) ss.
COUNTY OF SANTA CLARA)

I, MARGARET A. SIMMONS, a Notary Public in and for the County and State aforesaid, do hereby certify that Dave Napolitano, personally known to me to be the same person whose name is subscribed to the foregoing instrument, appeared before me this day in person and acknowledged that (s)he signed, sealed and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

IN WITNESS WHEREOF, I have hereunto set my hand and Notarial Seal, this
13 day of AUG, 1998 .



Margaret A. Simmons
Notary Public

My Commission Expires: FEB, 6, 2002

Case No. 5050/293ASSIGNMENT

WHEREAS, Charles E. Bradley, Gregory L. Holley, Lawrence J. Newell, David J. Hedberg and Dave Napolitano, hereinafter called the "Assignor", has made the invention described in the United States patent application entitled Ultrasonic Harmonic Imaging System And Method Using Waveform Pre-distortion, executed by Assignor on the same date of this Assignment;

WHEREAS, Acuson Corporation, a corporation organized and existing under the laws of the State of Delaware, having a place of business at Mountain View, California, hereinafter called the "Assignee", desires to acquire the entire right, title and interest in and to the invention and the patent application identified above, and all patents which may be obtained for said invention, as set forth below;

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00), and other valuable and legally sufficient consideration, the receipt of which by the Assignor from the Assignee is hereby acknowledged, the Assignor has sold, assigned and transferred, and by these presents does sell, assign and transfer to the Assignee, the entire right, title and interest for the United States in and to the invention and the patent application identified above, and any patents that may issue for said invention in the United States; together with the entire right, title and interest in and to said invention and all patent applications and patents therefor in all countries foreign to the United States, including the full right to claim for any such application all benefits and priority rights under any applicable convention; together with the entire right, title and interest in and to all continuations, divisions, renewals and extensions of any of the patent applications and patents defined above; to have and to hold for the sole and exclusive use and benefit of the Assignee, its successors and assigns, to the full end of the term or terms for all such patents.

The Assignor hereby covenants and agrees, for both the Assignor and the Assignor's legal representatives, that the Assignor will assist the Assignee in the prosecution of the patent application identified above; in the making and prosecution of any other patent


applications that the Assignee may elect to make covering the invention identified above; in vesting in the Assignee like exclusive title in and to all such other patent applications and patents; and in the prosecution of any interference which may arise involving said invention, or any such patent application or patent; and that the Assignor will execute and deliver to the Assignee any and all additional papers which may be requested by the Assignee to carry out the terms of this Assignment.

The Commissioner of Patents and Trademarks is hereby authorized and requested to issue patents to the Assignee in accordance with the terms of this Assignment.

IN TESTIMONY WHEREOF, the Assignor has executed this agreement.

DATED:

6/27/98



Charles E. Bradley

DATED:

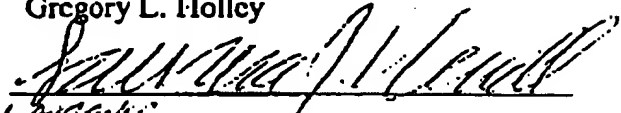
6/27/98



Gregory L. Holley

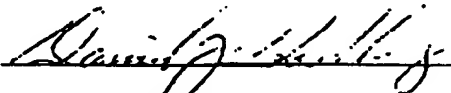
DATED:

6/29/98


LAWRENCE J. NEWELL
Lawrence J. Newell

DATED:


6/26/98



David J. Hedberg

DATED:

6/26/98



Dave Napolitano

Rev. Feb.97

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STATE OF CALIFORNIA)
) ss.
COUNTY SANTA CLARA)
OF

I, MARGARET A. SIMMONS, a Notary Public in and for the County and State aforesaid, do hereby certify that Charles E. Bradley, personally known to me to be the same person whose name is subscribed to the foregoing instrument, appeared before me this day in person and acknowledged that (s)he signed, sealed and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

IN WITNESS WHEREOF, I have hereunto set my hand and Notarial Seal, this
29 day of JUNE, 1998.



Margaret A. Simmons
Notary Public

My Commission Expires: FEB 6, 2002

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STATE OF CALIFORNIA)
) ss.
COUNTY SANTA CLARA)
OF

I, MARGARET A. SIMMONS, a Notary Public in and for the County and State aforesaid, do hereby certify that Gregory L. Holley, personally known to me to be the same person whose name is subscribed to the foregoing instrument, appeared before me this day in person and acknowledged that ~~(s)~~he signed, sealed and delivered the said instrument as his ~~her~~-free and voluntary act for the uses and purposes therein set forth.

IN WITNESS WHEREOF, I have hereunto set my hand and Notarial Seal, this 29 day of JUNE, 1998.



Margaret A. Simmons
Notary Public

My Commission Expires: FEB 6, 2002

STATE OF CALIFORNIA)
) ss.
COUNTY SANTA CLARA)
OF

I, MARGARET A. SIMMONS, a Notary Public in and for the County and State aforesaid, do hereby certify that Lawrence J. Newell, personally known to me to be the same person whose name is subscribed to the foregoing instrument, appeared before me this day in person and acknowledged that ~~(s)~~he signed, sealed and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

IN WITNESS WHEREOF, I have hereunto set my hand and Notarial Seal, this 29 day of JUNE, 1998.



Margaret A. Simmons
Notary Public

My Commission Expires: FEB 6, 2002

TR-135

STATE OF CALIFORNIA)
) ss.
COUNTY SANTA CLARA)
OF

I, MARGARET A. SIMMONS a Notary Public in and for the County and State aforesaid, do hereby certify that David J. Hedberg, personally known to me to be the same person whose name is subscribed to the foregoing instrument, appeared before me this day in person and acknowledged that ~~he~~ signed, sealed and delivered the said instrument as his/her free and voluntary act for the uses and purposes therein set forth.

IN WITNESS WHEREOF, I have hereunto set my hand and Notarial Seal, this 26 day of JUNE, 1998.



Margaret A. Simmons
Notary Public

My Commission Expires: FEB 6, 2002